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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,339	12/03/2001	Andreas Berg	112740-365	5137

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EXAMINER
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NGUYEN, KHAI MINH

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/006,339

Applicant(s)

BERG, ANDREAS

Examiner

Khai M Nguyen

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/03/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 rejected under 35 U.S.C. 102(e) as being anticipated by Donovan et al (US-6519468)

Regarding claim 1, Donovan teaches a method for transmitting short messages from a mobile terminal in a mobile radio network, the method comprising the steps of:

transmitting a short message from a mobile terminal ( see fig.1, Col.3, line 64- col.4, line 11);

receiving the short message by a mobile switching center ( see fig.1 and fig.2, Col.3, line 64- col.4, line 11);

forwarding the short message directly to a short message service center( see fig.1 and fig.2, Col.3, line 64- col.4, line 11);

starting an interrogation, via the short message service center, for a

home location register( see fig.1 and fig 2., Col.3, line 64- col.4, line 11);

determining, during the interrogation, information required for

delivery of the short message; and

determining the short message to a receiver with reference to the information (see fig.1 and fig.2, col.2, lines 6-15, col.3, line 51 to col.4, line 11 and col.5, lines 31-46).

Regarding claim 2, Donovan teaches a method for transmitting short messages from a mobile terminal in a mobile radio network as claimed in claim 1, the method further comprising the steps of

receiving, by the short message service center, an address of a service center responsible from the home location register ( fig.3 , col. 5, lines 54- 61); and

starting a dialog, via the short message service center, to the service center responsible (see fig.1 and fig.2, col.2, lines 6-21, col.3, line 51 to col.4, line 11 and col.5, lines 31-46).

3. Claims 3 and 5 rejected under 35 U.S.C. 102(e) as being anticipated by Mukherjee et al (US-6289223)

Regarding claim 3, Mukherjee teaches a method for receiving short messages from a mobile terminal in a mobile radio network, the method comprising the steps of

receiving a short message at a short message service center (fig.1 and fig.4);  
starting an interrogation, via the short message service center, at a home location register which is responsible for the mobile terminal ( fig.1 and fig.4, col.3 , lines 14-34);

determining, during the interrogation, information which is required for delivery of the short message;

starting a dialog, via the short message service center, to a responsible service center which is determined; and delivering the short message to a receiver by reference to the information (see fig.1, fig 4, fig.5, col.3, lines 14-33).

Regarding claim 5, Mukherjee teaches a method for receiving short messages from a mobile terminal in a mobile radio network as claimed in claim. 3, the method further comprising the step of delivering the short message to a third-party terminal if a delivery address has been changed by the responsible service center (fig.4, col.5, line 36 to col.6, line21).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee (US-6289223) in view of Lorello (US-6459904).

Regarding claim 4, Mukherjee teaches a method for receiving short messages from a mobile terminal in a mobile radio network as claimed in claim 3 (see fig.1, fig 4, fig.5, col.3, lines 14-33).

Mukherjee fails to specifically disclose the method further comprising the step of buffering the short message by the short message service center if the receiver cannot be reached. However, Lorello teaches the method further comprising the step of

buffering the short message by the short message service center if the receiver cannot be reached. ( see fig.5,col2, line 51 to col.3 , line 13;col.1, line 63 to col.2 , line 7 ).

Therefore it would have been obvious to one of ordinary skill the art at the time the invention was made to use the method further comprising the step of buffering the short message by the short message service center if the receiver cannot be reached as taught by Lorello with Mukherjee teaching in order to provide guaranteed delivery of short message to subscribers.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Meuronen(US-6597917) Discloses Mobile communication system which transmits messaging message.

b) Allison (Pub-20030083078) Discloses Short message service notification between multiple short message service centers.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khai M Nguyen whose telephone number is 703.05.3906. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703.308.7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Khai Nguyen  
AU:2684  
Date: 5/19/2004

  
**NICK CORSARO**  
**PATENT EXAMINER**